

REMARKS

Claims 1 to 14 are pending in the application.

Claims 4 to 7, 9, 11, and 13 are original.

Claims 2, 3, 10, 12, and 14 are cancelled.

Claims 1 and 8 are currently amended.

Claim 15 is new.

Claims 1, 4 to 9, 11, 13, and 15 would be all of the claims remaining in the application if the amendments are entered.

Discussion of Amendments

Claim 1 is amended to delete subject matter drawn to a non-elected invention in the definition of the groups W^1 , W^2 , and W^3 . Claims 2, 10, 12, and 14 are cancelled for being drawn to a non-elected invention. Claim 3 is cancelled for being redundant in view of the amendment of the definition of the groups W^1 , W^2 , and W^3 in Claim 1. Claim 8 is amended to change the dependencies because Claims 2 and 3 are cancelled. New Claim 15 finds support in Embodiment 5 on page 10 of the specification.

Applicants reserve their right to reintroduce claims embracing deleted or cancelled subject matter in this application or any continuations, divisionals, or continuations-in-part thereof.

Election/Restrictions

Applicants hereby affirm their telephonic election of the invention of Group II, Claims 1, 3-9, 11, and 13, drawn to compounds of formula I or II wherein one of W^1 , W^2 , and W^3 is N and the remaining two are carbons, corresponding composition and method of use, classified in class 546, subclass 122+. New Claim 15 embraces subject matter of the elected invention and thus Applicants believe Claim 15 does not place an undue search burden on the Examiner. Applicants hereby withdraw their traverse.

Applicants have not identified herein a species of the elected invention or listed any claims that are readable thereon because Applicants believe that the specification does not identify any such species.

Claim Rejections - 35 U.S.C. §103

Claims 1, 3, 4, 6, 7, 11 and 13 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Salituro et al., WO 99/64400. The Examiner alleged that the reference teaches a generic group of compounds which embraces applicant's instantly claimed compounds and points to formula I in page 9 wherein Z is NH; one of Y and A can be N and the remaining are carbons; X is -C(O)-O-, etc.; and Q₂ is aromatic carbocyclic or heterocyclic ring. The Examiner further alleged that the claims differ from the reference by citing a more limited genus than the reference.

Applicants respectfully traverse this rejection of Claim 3 on the grounds that Claim 3 is cancelled, rendering the rejection of Claim 3 moot. Applicants respectfully traverse this rejection of Claims 1, 4, 6, 7, 11, or 13 on the grounds that a *prima facie* case of obviousness has not properly been established because not all of the elements of the invention of Claims 1, 4, 6, 7, 11, or 13 are disclosed, taught or suggested in Salituro et al.

While *prima facie* obviousness of a claim to a subgenus may be properly alleged when a prior art reference discloses a genus that embraces the subgenus, that fact pattern is not present in this rejection. Salituro et al. discloses, *inter alia*, compounds of reference formula I, including such compounds wherein Z, if present, is N, NH or, if chemically feasible, O. The subject matter of Claims 1, 4, 6, 7, 11, and 13 does not constitute a more limited genus than the reference compounds because the reference compounds do not embrace, for example, the invention compounds of Claim 1 wherein R² is "C₁-C₆ alkyl; Phenyl-(C₁-C₈ alkylene); . . . Substituted phenyl-S(O)₂-(C₁-C₈ alkylene);" Accordingly, not all of the elements of the invention of Claims 1, 4, 6, 7, 11, and 13 are disclosed in Salituro et al.

Further, Applicants find no teaching or suggestion in Salituro et al. that would lead a skilled artisan to modify a compound of reference formula I, or for that matter of reference formulas II, III, IV, V, VI, or VII, by substituting the NH in group Z. Even the intermediates a, b, a', b', c, d, c', and d' in reference Schemes 1, 2, or 3 on pages 23 and 24 of Salituro et al. only describe compounds wherein Z is N, NH, or O.

Applicants believe that Salituro et al. fail to disclose, teach or suggest all of the elements of the invention of Claims 1, 4, 6, 7, 11, and 13, and thus a *prima facie* case of obviousness has not been properly established. Accordingly, Applicants believe that Claims 1, 4, 6, 7, 11, and 13 are nonobvious and patentable under 35 U.S.C. § 103(a) in view of Salituro et al.

Allowable Subject Matter

Applicants note that Claims 5, 8, and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Supplemental Information Disclosure Statement

Applicants further make available to the Patent and Trademark Office a Supplemental Information Disclosure Statement on form PTO/SB/08A and/or PTO/SB/08B and copies of the art cited thereon.

Applicants respectfully request that the Examiner consider carefully the complete text of the cited reference(s) in connection with the examination of the above-identified application in accord with 37 CFR §1.104(a).

It is respectfully requested that all cited reference(s) considered by the Examiner be listed in the "References Cited" portion of any patent issuing from the instant application (MPEP § 1302.12).

Conclusion

In view of the above amendment and remarks, Applicants believe that the objection to Claims 5, 8, and 9 and the rejection of Claims 1, 3, 4, 6, 7, 11 and 13 under 35 U.S.C. § 103, are overcome. Applicants request removal of the objections and rejections and reconsideration and allowance of Claims 1, 4 to 9, 11, and 13 and consideration and allowance of new Claim 15.

The undersigned would welcome a telephone call from the Office to discuss matters that might be resolvable by such communication.

Respectfully submitted,

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